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10/786,705

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Youngec Jung

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EXAMINER

PADMANABHAN, KAVITA

ART UNIT

PAPER NUMBER

2161

NOTIFICATION DATE

DELIVERY MODE

09/24/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/786,705

Applicant(s)

JUNG ET AL.

Examiner

Kavita Padmanabhan

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23, 48-70, 95 and 96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23, 48-70, 95 and 96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Status of Claims*

1. Claims 1-23, 48-70, 95, and 96 are pending.
2. Claims 24-47 and 71-94 have been cancelled.
3. Claim 96 has been added.
4. Claims 1, 2, 5, 6, 9, 13-16, 18, 21, 48, 49, 52, 53, 56, 60-63, 65, 68, and 95 have been amended.
5. Claims 1-23, 48-70, 95, and 96 are rejected.

### *Continued Examination Under 37 CFR 1.114*

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/26/07 has been entered.

### *Claim Rejections - 35 USC § 112*

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. **Claims 17 and 64** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "IEEE 802.15.1" does not appear to be supported by the applicant's original disclosure.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claim 96** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 96** recites the limitation "the hand-held device within the short-range communication range" in the last limitation of the claim. There is insufficient antecedent basis for this limitation in the claim since the same claim also recites both "a hand-held device within a short-range communication range" and "one or more other hand-held devices encountered within the short-range communication range".

#### ***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. **Claim 95** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must produce a useful, concrete and tangible result.

In regards to **claim 95**, the system claimed is not directed to statutory subject matter, in that it appears that the means recited include embodiments that consist purely of software, which is not statutory. This assertion is evidenced by claim 48, which recites, in part, a system comprising program code, wherein the program code causes the processor to perform the limitations claimed in claim 95. Therefore, the means of claim 95 could clearly be program code, or software. Claim 95 is therefore not limited to statutory subject matter.

The examiner will apply prior art to these claims as best understood, with the assumption that applicant will amend to overcome the stated 101 rejections.

### ***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. **Claims 1-3, 6-16, 19-22, 48-50, 53-63, 66-69, 95, and 96** are rejected under 35 U.S.C. 102(b) as being anticipated by **Robertson** (US 6,269,369).

In regards to **claim 1, Robertson** teaches a method, comprising:

- receiving data at a first hand-held device (**Robertson; col. 4, lines 56-60 – clients may be hand-held devices, such as Palm Pilots; col. 13, lines 18-23 – “if a first user lives in Boston but is traveling to New York on March 5, then the first user will be informed if any contacts will be crossing paths on that day in either city”; Fig. 14**);
- creating a log entry in accordance with a match found between the data received at the first hand-held device and data held by a second hand-held device within a short-range communication range of the first hand-held device (**Robertson; Fig. 14; col. 16, Appendix A – shows matching; col. 20, Appendix I – a list constitutes a log of entries**); and
- providing a socially-relevant recommendation to a user of the first hand-held device relating to the data received at the first hand-held device after one or more criteria have been met, wherein the criteria include a specification of at least a predefined number of matches between the data received at the first hand-held device and data held by one or more other hand-held devices encountered within the short-range communication range of the first hand-held device (**Robertson; Fig. 8; col. 13, lines 18-23 - “if a first user lives in Boston but is traveling to New York on March 5, then the first user will be informed if any contacts will be crossing paths on that day in either city” – constitutes a socially-relevant recommendation after one or more criteria are met; col. 14, lines 27-61; Fig. 12**).

In regards to **claim 2, Robertson** teaches the method of claim 1, wherein the data received at the first hand-held device includes at least an identifier for data held by the second hand-held device (**Robertson; col. 10, lines 54-61; col. 11, lines 50-59; Fig. 7; col. 14, lines 27-61; Fig. 12**).

In regards to **claim 3, Robertson** teaches the method of claim 2, wherein the identifier is a unique identifier (**Robertson; col. 16, lines 7-21**).

In regards to **claim 6, Robertson** teaches the method of claim 2, wherein the data received at the first hand-held device includes a data element held by the second hand-held device (**Robertson; col. 4, lines 56-59; col. 11, lines 50-59; col. 14, lines 27-61; col. 16, lines 7-21**).

In regards to **claim 7, Robertson** teaches the method of claim 6, wherein the data element is a phone number (**Robertson; col. 11, lines 50-59; Fig. 7**).

In regards to **claim 8, Robertson** teaches the method of claim 6, wherein the data element is a universal resource locator (**Robertson; col. 16, lines 56-57**).

In regards to **claim 9, Robertson** teaches the method of claim 1, wherein the data received at the first hand-held device is not browsable by the user (**Robertson; col. 11, lines 50-**

**59; col. 16, lines 56-57 – for example, although not displayed/”browsable”, address id must have been sent in order to update the local PIM data).**

In regards to **claim 10, Robertson** teaches the method of claim 1, further comprising determining if the user already possesses data relating to the socially-relevant recommendation **(Robertson; Fig. 14).**

In regards to **claim 11, Robertson** teaches the method of claim 1, wherein the recommendation is provided at a particular period of time after the one or more criteria have been met **(Robertson; col. 11, lines 28-32; col. 14, lines 27-30).**

In regards to **claim 12, Robertson** teaches the method of claim 1, wherein the recommendation is provided at a particular time of day after one or more criteria have been met **(Robertson; col. 11, lines 28-32; col. 14, lines 27-30 – “particular time of day” is a broad limitation; since a recommendation is clearly provided at a particular time, that time at which the recommendation is provided is interpreted to be “the particular time of day”).**

In regards to **claim 13, Robertson** teaches the method of claim 1, wherein the recommendation is provided after the user performs an operation with the first hand-held device **(Robertson; col. 5, lines 5-19; Fig. 7; Fig. 12).**



In regards to **claim 14, Robertson** teaches the method of claim 1, wherein the recommendation suggests to the user addition of data relating to the data received at the first hand-held device (**Robertson; Fig. 8**).

In regards to **claim 15, Robertson** teaches the method of claim 14, wherein the data suggested for addition is held by the second hand-held device (**Robertson; col. 10, lines 10-16; Fig. 14; col. 16, lines 7-21**).

In regards to **claim 16, Robertson** teaches the method of claim 1, wherein the first hand-held device employs short-range communication in communicating with the second hand-held device (**Robertson; Fig. 14**).

In regards to **claim 19, Robertson** teaches the method of claim 1, wherein one or more criteria provide for weighting of log entries (**Robertson; col. 20, Appendix I – certain matches/log entries are given higher/lower weight depending on permissions**).

In regards to **claim 20, Robertson** teaches the method of claim 1, wherein the recommendation is not provided after expiration of a validity period (**Robertson; col. 11, lines 28-32**).

In regards to **claim 21, Robertson** teaches the method of claim 1, wherein the data received at the first hand-held device is updated (**Robertson; col. 4, lines 42-45; Fig. 11**).

In regards to **claim 22, Robertson** teaches the method of claim 1, wherein the user is directed to a source for information regarding data suggested by the recommendation (**Robertson; Fig. 8; Fig. 11; Fig. 12 – the people listed are sources of information; col. 16, lines 56-57**).

**Claims 48-50, 53-63, and 66-69** are rejected with the same rationale given for claims 1-3, 6-16, and 19-22, respectively.

**Claims 95 and 96** are each rejected with the same rationale given for claim 1.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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17. **Claims 17, 23, 64, and 70** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robertson** in view of **Tsou et al.** (US 2002/0184089, hereinafter “Tsou”).

In regards to **claim 17**, **Robertson** teaches the method of claim 16.

**Robertson** does not expressly teach employing IEEE 802.15.1 for the short-range communications.

**Tsou** teaches Bluetooth as an exemplary wireless communication protocol (**Tsou; par [0032]; par [0039]**).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of **Robertson** using the Bluetooth communication protocol, as taught by **Tsou**, to send and receive information between wireless devices (**Tsou; par [0032]; par [0039]**).

In regards to **claim 23**, **Robertson** teaches the method of claim 1.

**Robertson** does not expressly teach an advertiser learning if the user complied with the recommendation.

**Tsou** teaches providing a wireless user with promotional advertisements and providing the advertiser with statistics regarding the effectiveness of those advertisements (**Tsou; par [0016] – par [0018]**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of **Robertson**, whereby users would be notified of promotional offers/recommendations from advertisers, and the advertisers would be notified of

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whether the users clicked on, i.e. complied with, the recommended promotions (**Tsou; par [0049]; par [0052]**).

**Claims 64 and 70** are rejected with the same rationale given for claims 17 and 23, respectively.

18. **Claims 18 and 65** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robertson** in view of **Young et al.** (US 7,024,690, hereinafter “Young”).

In regards to **claim 18**, **Robertson** teaches the method of claim 1.

**Robertson** does not expressly teach employing a one-way hash of a unique identifier associated with the second hand-held device in creating the log entry.

**Young** teaches employing one-way hashes of identifiers to enhance security of wireless communications (**Young; Abstract**).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of **Robertson**, whereby the communication of data between the user hand-held devices is made more secure by employing one-way hashing, as taught by **Young** (**Young; Abstract**). The data transmitted to/from the wireless clients of **Robertson**, which is then used in determining matches/log entries, would thereby be more trusted.

**Claim 65** is rejected with the same rationale given for claim 18.

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19. **Claims 4 and 51** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robertson** in view of **Bieganski et al.** (US 6,412,012, hereinafter “Bieganski”).

In regards to **claim 4**, **Robertson** teaches the method of claim 2.

**Robertson** does not expressly teach the identifier being an international standard book number.

**Bieganski** teaches recommending books to users via international standard book number (ISBNs) based on matches with books already selected by the user (**Bieganski; col. 18, line 50 – col. 19, line 11**).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of **Robertson**, whereby ISBNs are sent to a user to recommend books that may be of interest to the user (**Bieganski; col. 18, line 50 – col. 19, line 11**).

**Claim 51** is rejected with the same rationale given for claim 4.

20. **Claims 5 and 52** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robertson** in view of **Spooner** (US 2005/0034099).

In regards to **claim 5**, **Robertson** teaches the method of claim 2.

**Robertson** does not expressly teach the identifier being an international mobile equipment identity identifier.

**Spooner** teaches the use of a session specific identifier within a Symbian OS (**Spooner; par [0023]**).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of Robertson using a Symbian identifier, as taught by Spooner, in order to check whether users or devices have the necessary rights to communicate (**Spooner; par [0023]**).

**Claim 52** is rejected with the same rationale given for claim 5.

#### ***Response to Amendment***

21. Applicant's amendments filed 7/26/07 with respect to claims 5 and 52 have been fully considered. The previous objections to those claims have been withdrawn accordingly.

22. Applicant's amendments filed 7/26/07 with respect to the 35 USC 112, 2<sup>nd</sup> paragraph rejections have been fully considered. The previous rejections have been withdrawn accordingly.

#### ***Response to Arguments***

23. Applicant's arguments filed 7/26/07 with respect to the 35 USC 112, 1<sup>st</sup> paragraph rejections have been fully considered but they are not persuasive.

While the examiner agrees that "short-range communications might, for example, employ Bluetooth, IEEE 802.15a, IEEE 802.15.3, 802.11a, 802.11b, 802.11g", as recited in the applicant's specification, the examiner maintains that the use of IEEE 802.15.1 is not supported,

as it does not appear to have been contemplated by the applicant at the time of the applicant's invention. Therefore, the rejections are maintained. Furthermore, since the applicant states that IEEE 802.15.1 corresponds to Bluetooth, for which there is support in the specification, the examiner respectfully suggests amending the claims to use the language that is clearly supported.

24. Applicant's arguments filed 7/26/07 with respect to the prior art rejections of the claims have been fully considered but they are not persuasive.

Applicant argues at page 14 of applicant's remarks that Robertson does not teach "creating a log entry in accordance with a match found between data received at 'Client Computer B' and data held by 'Client Computer A'", apparently with reference to Figure 14 of Robertson. The examiner respectfully disagrees with the applicant's argument. The examiner asserts that in addition to Fig. 14, the examiner relied on Appendices A and I with respect to the limitation in question. In fact, the examiner explains that Fig. 14 was cited to show the configuration the examiner is relying upon, and Appendices A and I were cited to show the claimed functionality. Appendix I clearly describes a matching function that results in creating a list, i.e. a log, of names, each entry in the list constituting a log entry, thereby meeting the claimed limitation.

Applicant argues at page 15 of applicant's remarks that the functionality corresponding to Fig. 14 of Robertson is separate from the functionality corresponding to Appendix A and Appendix I of Robertson. The examiner respectfully disagrees. The examiner asserts that Fig. 14 simply describes an alternative configuration for the system of Robertson, however the functionality attributed to Appendices A and I still apply to the system depicted in Fig. 14 (Robertson; col. 15, lines 42-65).

***Conclusion***

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kavita Padmanabhan** whose telephone number is **571-272-8352**. The examiner can normally be reached on Monday-Friday, 9:00am-5:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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September 15, 2007

  
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SUPERVISORY PATENT EXAMINER